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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,122	12/14/2001	Jeanette McCarthy	MMI-007	9042

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EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT PAPER NUMBER

1634

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,122

Applicant(s)

MCCARTHY, JEANETTE

Examiner

Jeanine A Goldberg

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-130 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-130 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-30, 41-57, drawn to a method for identifying a subject as a candidate for a particular clinical course of therapy to treat a vascular disease by determining the nucleotides present at positions 594 and/or 8401 of SEQ ID NO: 1, classified in class 435, subclass 6.
 - II. Claims 31-32, drawn to a computer readable medium, classified in class 707, subclass 1.
 - III. Claims 33-39, drawn to an electronic system comprising a processor and a network system, classified in class 702, subclass 19.
 - IV. Claims 40, 73-80, 83-130 drawn to a method for determining whether a subject has a pre-disposition by receiving information and acquiring information from the network, internet based methods, classified in class 702, subclass 22 or 707/ 3.
 - V. Claims 58-61, drawn to an isolated nucleic acid comprising a nucleotide sequence comprising an allelic variant and kits comprising probes and primers, classified in class 536, subclass 23.1.
 - VI. Claims 62-72, drawn to a method of identifying allelic variants in a polymorphic region of an F7 gene, classified in class 435, subclass 6.

2. The inventions are distinct, each from the other because of the following reasons:

A) The inventions of Group I, IV, VI are patentably distinct methods because they each have different objectives, different uses, different reagents and different method steps. The method of Group I is for genetic analysis of nucleic acid molecules to identify the presence of a polymorphism associated with vascular disease.

Alternatively, the method of Group IV is for electronic analysis of a polymorphic region of an F7 gene. Finally, the method of Group VI is designed to identify allelic variants within a nucleic acid molecule. Each of these groups are designed to serve alternative functions and do not require the same reagents and method steps. Therefore the methods are distinct over one another.

B) The inventions are distinct, each from the other because of the following reasons: The inventions of Groups II, III and V are patentably distinct because they are drawn to different products having different structures and functions. The nucleic acid of Group V is composed of nucleotides linked in phosphodiester bonds and arranged in space as a double helix. The electronic system of Group III comprises a processor. The computer readable medium of Group II is a storage means. Furthermore, the products of Groups II, III, and V can be used in materially different processes, for example, the DNA of Group I can be used in hybridization assays, the computer readable medium may be used to store information for later analysis and the electronic system may be used to perform calculations of similarity or frequency. Consequently, materials required to make or use each invention are different. Therefore, the inventions of Groups II, III and V are patentably distinct from each other.

C) Inventions V and (I and VI) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acid may be used in materially different methods such as hybridization assays, aptamer screening assays, antisense methods, or purification methods.

D) Group (II and (I, IV, VI)) and Group (III and (I, IV, VI)) and Group (V and IV) are patentable distinct inventions because the nucleic acid computer readable storage medium and electronic systems of Groups II, III and V is not relied upon in the method of Group (I, IV, VI), (I, IV, VI) or IV, respectively. Instead Group I uses nucleic acids, Group IV uses internet and electronic means and Group IV uses nucleic acids. Therefore, the inventions are novel and unobvious over one another.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the different classifications and their divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is

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(703) 306-5817. The examiner can normally be reached Monday-Friday from 8:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax number for this Group is (703) 305- 3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

J. Goldberg
Jeanine Goldberg
April 9, 2003

B. J. Forman
B. J. FORMAN
PATENT EXAMINER